

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

REMARKS

Applicant has carefully reviewed the above identified application in view of Examining Attorney's Office Action of July 20, 2007. Applicant appreciates the thoroughness of Examining Attorney's review of this application in noting several typographical errors. The above amendments to the specification correct many of the typographical errors noted by Examining Attorney, in the manner suggested by Examining Attorney, as well as correcting several additional typographical errors, one of the changes suggested by Examining Attorney has not been made. This is:

Examining Attorney contends that the specification at page 3, line 9 the word "panel" should be replaced by "panels". This portion now reads:

"Each of the top panel and bottom panel has an outer surface and an inner surface and the..."

It is respectfully submitted that since there is only one top panel and one bottom panel, the singular version of the word "panel" to designate each of the top panel, such as top panel designated 12 on Figure 1, and bottom panel, such as bottom panel designated 16 on Figure 1 is appropriate.

These remarks are addressed to the rejection of claims 32 to 41, the claims now in this application, the remaining claims from the as filed Application having been cancelled without prejudice subject to being filed in one or more divisional or continuation application.

No claims have been amended. No claims have been cancelled. No claims have been added. Claim 32 is the only independent claim in the application: claims 33 to 41 inclusive being

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

dependent on claim 32. In view of the following remarks, it is respectfully submitted that each of claims 32 to 41 are allowable and early allowance thereof is respectfully requested.

It is respectfully submitted that it is only a combination of the prior art in view Applicant's teaching that shows or suggests the invention made by Applicant and the problems solved by Applicant in providing the light weight composite construction module of the present invention.

Examining Attorney has rejected claims 32 to 41 under 35 USC § 103 as obvious in view of a combination of De Zen 6253527 in view of Klasell et al 5439749. Examining Attorney contends that De Zen shows a top panel, a bottom panel and an intermediate panel with peripheral wall members defining a cavity. Examining Attorney admits that the panels of De Zen do not have a plurality of thin sheet laminate layers bonded together. Examining Attorney contends that Klasell teaches a composite wood structure and refers to Figures 5 and 6 as showing a composite wood structure (52 or 53) having a plurality of sheet laminate layers bonded together. The attention of Examining Attorney is respectfully directed to Klasell column 4 lines 40 to 42 where Klasell states:

“FIG 5 is an isometric view of a piece of laminated lumber.”

“FIG. 6 is an isometric view of a piece of plywood”

and to column 5 line 67 to column 6 line 6 wherein Klasell states:

“Referring next to FIGS 4 through 9, while core 29 of LVL 29a is preferred in many instances, the core 29 of the invention structure 6 is not limited to such materials. Such core 29 may be made of a material selected from a group of core materials comprising, in addition, ...

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

laminated lumber 51 (Fig. 5), plywood 53 (Fig. 6)..."

Thus, Klasell is using the laminate **only for the core 29, and not the top or bottom layers 25 and 27**. As clearly shown on FIG. 3 the top and bottom layers 25 and 27 are a **single** construction and as defined at column 5 lines 23 to 29:

"Referring now to FIG. 3, one Example of the new composite wood structure 10 has first and second spaced layers with a core 29 interposed between the layers. The layers 25, 27 may be, for example, composite board such as high-density particle board, medium density fiberboard, hardwood or other suitable wood composite structures."

Applicant, of course, is not contending that Applicant is the inventor of plywood sheets. Such have been in use for many decades and are generally available in many thicknesses.

There is no showing in Klasell of using a thin sheet laminate structure for the top and bottom layers. In fact, Klasell teaches away from construction by specifically limiting the laminate structure to core 29. It is only the teaching of Applicant that defines the inventive advance of using the thin sheet laminate as both the top and bottom layers as set forth in claim 32. There is no combination of Klasell with De Zen that can provide the invention as defined in claim 32. Any combination of Klasell with De Zen would result in only the substitute of the composite core 29 of Klasell for the substructure 1 **since De Zen specifically requires that the outer and inner plates of the composite door are steel**. See Column 5 lines 9 to 25.

Independent claim 32 clearly defines structure that is not obvious on the showing of De Zen in view of Klasell. Thus, claim 32 clearly teaches the combination of the top panel having a

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

first plurality of thin sheet laminate layers bonded together and a bottom panel having a second plurality of then sheet laminate layers bonded together. De Zen has a middle structure between the two outer panels that is **not a laminate** but is a mixture of particulate matter bound together by a plastic binder. See column 5 lines 13 - 18 and FIG. 2. Both De Zen and Kasell teach away from Applicant's construction in that, as mentioned above, De Zen has steel as the material for the cover plates and Kasell has a single panel, not a laminate, as the inside and outside panels even though he uses a laminate as the core. Thus, there are, virtually, an infinite number of materials and constructions that could be used for the top and bottom panels (inner and outer panels or layers) such as the steel by De Zen and the single panel of composite board, hardboard or other suitable wood composite products of Kasell

The recent Supreme Court case of *KSR International Co. v. Teleflex Inc. Et all* , No. 04-1350, 550 U.S. ____ (2007) , fully supports the reasoning set forth above for the allowance of claims 32 to 41. As stated therein:

“In *United States v. Adams*, 383 U.S. 39,40 (1966), a companion case to *Graham*¹, the Court considered the obviousness of a “wet battery” that varied from prior design designs in two ways: It contained water, rather than acids conventionally employed in storage batteries; and its electrodes were magnesium and cuprous chloride, rather than zinc and silver chloride. The Court recognized that when a patent claims a structure already known in the prior art that is altered by the mere substitution of one element for another

¹ *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1 (1966)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

known in the field, the combination must do more than yield a predictable result. 383 U.S. at 50-51. It nevertheless rejected the Government's claim that Adam's battery was obvious. The Court relied upon the corollary principle that when the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious. *Id.*, at 51-52. When Adams designed his battery, the prior art warned that risks were involved in using the types of electrodes he employed. The fact that the elements worked together in an unexpected and fruitful manner supported the conclusion that Adam's design was not obvious to those skilled in the art." ...

"Following these principles may be more difficult in other cases than it is here because the claimed subject matter may involve more than the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for the improvement. Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be made explicit. See *In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006) ("[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness"). As our

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

precedents make clear, however, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.”...

“ As is clear from cases such as Adams, a patent composed of several elements is not proved obvious merely by demonstrating that each element was, independently, known in the prior art. Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed invention does.” (Footnote added).

It is respectfully submitted that Examining Attorney has not identified a “reason” for combining the elements of Claim 32 in the manner set forth therein in view of the virtually infinite structures that could be used for the top and bottom panels. Applicant’s invention as set forth in independent claim 32 teaches a new construction module arrangement that is not shown by the prior art which, in fact teaches away from the invention of Applicant.

Contrary to the holding in the KSR case, Examining Attorney has merely taken bits and pieces of the cited prior art, utilizing hindsight reconstruction, combined them in the manner taught by Applicant. Claim 32 and dependent claims 33 through 41 are clearly allowable.

Examining Attorney has also stated additional combinations of De Zen and Klasell pertaining to claims 33 to 41. While all of claims 33 to 41 are clearly allowable since they are

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

dependent on independent claim 32 the following remarks are presented as to each grouping specified by Examining Attorney. As to claims 33 to 35, Examining Attorney contends that Klasell discloses layers being made from laminated veneer lumber or "LVL" for decorating and waterproofing. Claims 33 to 35 are further definitions of Applicant's invention of independent claim 32 and do specify the use of an outer layer of veneer on the panels. As to claims 36 to 38, Examining Attorney contends that De Zen shows the top panel and the bottom panel bonded to the intermediate panel. The steel panels of De Zen may, of course, be, as specified by De Zen at column 5 lines 17 - 18 be coupled to the inner panel by nails, screws, industrial glues, De Zen is not a lightweight construction and cannot be fabricated in the manner taught by Applicant using the construction of the module as recited in claims 32 - 41. Claims 36 to 38 variously specify the bonding of Applicant's top and bottom panel to the intermediate panel. But the bonding is an integral part of the construction of the module of these claims. Examining Attorney has stated that, with respect to claims 39 - 41, that the combination of De Zen Figure 1 as modified by Klasell Figures 5 and 6 would meet the limitation of each panel having the same number of layers. There is no suggestion in either De Zen or Klasell of such a limitation. Rather, as noted above, De Zen has **steel** cover plates and Klasell has only a single outer layer on each side of the core. Claims 39 to 41 teach the use of the same number of layers in the top, intermediate and bottom panels.

Applicant's invention herein provides the economic advantage for the manufacturer to have an inventory of only one type of laminate layer which is used in all the panels of

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant's module. The construction of both De Zen and Klasell do not provide this advantage since each requires totally different materials for the outer layers as compared to the inner layer.

Applicant has attempted to respond to all points raised by Examining Attorney in the Office Action of July 20, 2007. As noted above, according to the requirements expressed by the Supreme Court in the KSR case, the invention as set forth in claims 32 to 41 are clearly allowable and early allowance thereof is respectfully requested.

A check in the amount of \$550.00 under 37 CFR 1.17(a)(3) is enclosed for the three month extension of time.

LAW OFFICES OF DON FINKELSTEIN
Don B. Finkelstein, Esq.
3858 Carson Street, Suite 216
Torrance, CA 90503
Phone: (310) 543 0070
Fax: (310) 543 7570

Respectfully submitted,



Don Finkelstein
Attorney for Applicant
Date: January 17, 2008